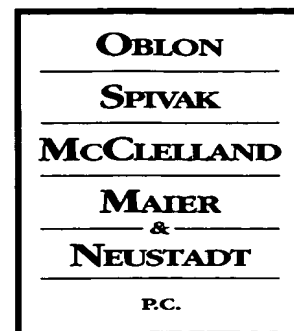




1645



Docket No.: 221519US0PCT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

ATTORNEYS AT LAW

RE: Application Serial No.: 10/089,057
Applicants: Seiko HIRANO, et al.
Filing Date: April 3, 2002
For: GENES FOR HEAT RESISTANT ENZYMES OF
AMINO ACID BIOSYNTHETIC PATHWAY
DERIVED FROM THERMOPHILIC CORYNEFORM
BACTERIA
Group Art Unit: 1645
Examiner: Navarro, A.

SIR:

Attached hereto for filing are the following papers:

Response to Restriction Requirement
Copy of MPEP, Annex B, Part 2, Example 17
International Preliminary Examination Report

Our check in the amount of \$0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
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Doc. No.: 2219US0PCT

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF:

Seiko HIRANO ET AL : EXAMINER: NAVARRO, A. M.

SERIAL NO.: 10/089,057 :

FILED: APRIL 3, 2002 : GROUP ART UNIT: 1645

FOR: GENES FOR HEAT RESISTANT ENZYMES OF AMINO ACID BIOSYNTHETIC
PATHWAY DERIVED FROM THERMOPHILIC CORYNEFORM BACTERIA

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VA 22313-1450

SIR:

Responsive to the Official Action dated April 5, 2004, Applicants elect, with traverse,
Group XXXVII (Claims 45-46, and 49 drawn to a DNA which codes for SEQ ID NO: 80) for
further prosecution.

REMARKS

The Office has required restriction in the present application as follows:

Group I, Claim 1, drawn to a protein having SEQ ID NO: 2;

Group II, Claim 2, drawn to a protein having SEQ ID NO: 4;

Group III, Claim 3, drawn to a protein having SEQ ID NO: 6;

Group IV, Claim 4, drawn to a protein having SEQ ID NO: 8;

Group V, Claim 5, drawn to a protein having SEQ ID NO: 10;

Group VI, Claim 6, drawn to a protein having SEQ ID NO: 94.

Group VII, Claim 7, drawn to a protein having SEQ ID NO: 17;

Group VIII, Claim 7, drawn to a protein having SEQ ID NO: 18;

Group IX, Claim 7, drawn to a protein having SEQ ID NO: 19;
Group X, Claim 7, drawn to a protein having SEQ ID NO: 20;
Group XI, Claim 8, drawn to a protein having SEQ ID NO: 22;
Group XII, Claim 9, drawn to a protein having SEQ ID NO: 24;
Group XIII, Claim 10, drawn to a protein having SEQ ID NO: 26;
Group XIV, Claim 11, drawn to a protein having SEQ ID NO: 28;
Group XV, Claim 12, drawn to a protein having SEQ ID NO: 30;
Group XVI, Claim 13, drawn to a protein having SEQ ID NO: 32;
Group XVII, Claim 14, drawn to a protein having SEQ ID NO: 34;
Group XVIII, Claim 15, drawn to a protein having SEQ ID NO: 80;
Group XIX, Claim 16, drawn to a protein having SEQ ID NO: 90;
Group XX, Claims 17-18 and 49, drawn to a DNA which codes for SEQ ID NO: 2;
Group XXI, Claims 19-20 and 49, drawn to a DNA which codes for SEQ ID NO: 4;
Group XXII, Claims 21-22 and 49, drawn to a DNA which codes for SEQ ID NO: 6;
Group XXIII, Claims 23-24 and 49, drawn to a DNA which codes for SEQ ID NO: 8;
Group XXIV, Claims 25-26 and 49, drawn to a DNA which codes for SEQ ID NO:
10;
Group XXV, Claims 27-28 and 49, drawn to a DNA which codes for SEQ ID NO: 93;
Group XXVI, Claims 29-30 and 49, drawn to a DNA which codes for SEQ ID NO:
17;
Group XXVII, Claims 29-30 and 49, drawn to a DNA which codes for SEQ ID NO:
18;
Group XXVIII, Claims 29-30 and 49, drawn to a DNA which codes for SEQ ID NO:
19;
Group XXIX, Claims 29-30 and 49, drawn to a DNA which codes for SEQ ID NO:
20;
Group XXX, Claims 31-32 and 49, drawn to a DNA which codes for SEQ ID NO: 22;
Group XXXI, Claims 33-34 and 49, drawn to a DNA which codes for SEQ ID NO:
24;
Group XXXII, Claims 35-36 and 49, drawn to a DNA which codes for SEQ ID NO:
26;

Group XXXIII, Claims 37-38 and 49, drawn to a DNA which codes for SEQ ID NO:
28;

Group XXXIV, Claims 39-40 and 49, drawn to a DNA which codes for SEQ ID NO:
30;

Group XXXV, Claims 41-42 and 49, drawn to a DNA which codes for SEQ ID NO:
32;

Group XXXVI, Claims 43-44 and 49, drawn to a DNA which codes for SEQ ID NO:
34; and

Group XXXVII, Claims 45-46 and 49, drawn to a DNA which codes for SEQ ID NO:
80.

Group XXXVIII, Claims 47-49, drawn to a DNA which codes for SEQ ID NO: 90.

Applicants elect, with traverse, Group XXXVII (Claims 45-46, and 49 drawn to a DNA which codes for SEQ ID NO: 80) for further prosecution.

At the outset, Applicants note that the Examiner has not made a proper case under the PCT rules to support the lack of unity. In particular, Applicants note that claims drawn to a protein (Groups I-XIX) and claims drawn to a DNA (Groups XX-XVIII) encoding the same satisfy the unity of invention criteria. The Examiner's attention is directed to the **enclosed** copies of the PCT administrative instructions in the MPEP, Annex B, Part 2, Example 17, which clearly indicates that a "protein and the DNA sequence exhibit corresponding special technical features."

Applicants further traverse that Restriction Requirement on the grounds that the Office has not applied the same standard of unity of invention as the International Preliminary Examination Authority (a copy of the International Preliminary Examination Report is **submitted herewith** for the Examiner's convenience). The Authority did not take the position that unity of invention was lacking in the International application and examined all claims together. Applicants note that PCT Article 27(l) states:

No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations.

Moreover, Applicants respectfully traverse on the grounds that the Office has not shown that a burden exists in searching the entire application.

MPEP in §803 states as follows:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. In fact, the International Searching Authority has searched all of the claims together.

Applicants submit that the present application is in condition for examination on the merits. Early notification to this effect is respectfully requested.

Respectfully submitted,

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